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Assistant Commissioner for Patents
Washington, D.C. 20231

By: Daniel Miranda

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Examiner: N. Lucchesi
PHAN, LOC X.	Art Unit: 3732
Application No.: 09/641208	
Filed: August 18, 2000	
For: METHODS AND SYSTEMS FOR LUBRICATING DENTAL APPLIANCES	**PRELIMINARY REMARKS**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Concurrent with filing a Continuing Prosecution Application (CPA), and in response to the Final Office Action mailed May 7, 2002, in the parent application, Applicant respectfully requests reexamination and reconsideration of the claims without amendment.

Claims 1-38 were examined and rejected for judicially created obviousness-type double patenting. Such rejections are traversed in part and have been overcome in part as discussed below.

Claims 19-38 were rejected for double patenting over commonly owned U.S. Patent No. 6,217,325. The double patenting rejection has been overcome by submission of a Terminal Disclaimer. Applicant further notes that while, prior to filing

the present CPA, the '325 patent would have been available as prior art §35 USC §102(e), with the refiling, the '325 patent is no longer available under the recent revisions to §103(c).

Claims 1-18 were rejected for double patenting over U.S. Patent No. 5,975,893. While the double patenting rejection could be overcome by submission of a Terminal Disclaimer, Applicant notes that the '893 patent is available as prior art under 35 USC §102(b). Thus, if the Examiner's position were correct, the claims are in fact obvious over the combination of the teachings (including the claims) of the '893 patent in view of Morrow et al., and the filing of a Terminal Disclaimer should not overcome such obviousness.

Applicant continues to believe, however, that teachings of Morrow et al. would not render the present claims obvious.

As is well-known to the Examiner, rejection for obviousness not only requires that the various claim elements be present in the cited art, but also that either the prior art references or general knowledge in the art suggest the desirability of the combination being relied upon. In the present case, the combination of the lubricated mouth guard of Morrow et al. with the tooth aligners of the '893 patent is in fact contraindicated by the references. The mouth guard of Morrow et al. is intended to protect the teeth from unintentional trauma and movement caused by impact to the mouth. Thus, it is important that the mouth guard be able to slide freely relative to the teeth. In contrast, the aligners of the '893 patent **are intended to move teeth**. Prior to the present invention, one skilled in the art would have questioned whether or not the aligners could be effective when lubricated. While the present invention has determined that in fact they can be effective, nothing in the prior art would have taught or suggested this result. For these reasons, Applicant believes that claims 1-18 are patentable over the combination of the '893 patent and the Morrow et al. patent, regardless of whether the rejection is made for double patenting or simply under §103.

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In view of the above amendments and remarks, Applicant believes that all claims submitted in the present CPA are allowable over the art and request that the application be passed to issue at an early date.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 650-326-2400.

Respectfully submitted,

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Reg. No. 29,541

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